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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/024,333  
Filing Date: December 21, 2001  
Appellant(s): RUBINSTENN ET AL.

\_\_\_\_\_  
Anthony M. Gutowski  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 2, 2008 appealing from the Office action mailed April 15, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is essentially correct.

**NEW GROUND(S) OF REJECTION**

**Claims 1 – 6, 8 – 10, and 12 – 30** are rejected under 35 U.S.C. 101 because based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiner is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an

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article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

6081611

LINFORD ET AL.

6-2000

Rodan & Fields Proactive Solution, retrieved from Wayback Machine, Proactiv Solution Skin Care, Pages Used:

May 21, 2001

[http://web.archive.org/web/20010521145551rn\\_1/www.proactive.com/index.php](http://web.archive.org/web/20010521145551rn_1/www.proactive.com/index.php)

February 15, 2001, April 11, 2001

<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

June 17 2001

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>,

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Priority***

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1 – 6, 8 – 10, and 12 – 30** are rejected under 35 U.S.C. 101 because based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiner is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class. Thus, **claims 1 – 6, 8 – 10, and 12 – 30** are non-statutory since they may are not tied to another statutory class.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 31 – 36, 38 – 45, and 47** are rejected under 35 U.S.C. 102(b) as being anticipated by **Linford et al. (US Patent 6,081,611)**.

5. In regards to **claim 31**, **Linford** discloses a system for enabling determination of prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one representation of the subject's external body condition (**Col. 5 Lines 30 – 57**);

a database for storing information on how use of at least one beauty product affects evolution of the external body condition (**Col. 5 Lines 30 – 57**);

a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product (**Col. 5 Lines 30 – 57**); and

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a driver for outputting the prognosis to enable the subject to receive the prognosis  
**(Col. 5 Lines 30 – 57).**

6. In regards to **claim 32**, **Linford** discloses a system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

means for receiving at least one representation of the subject's external body condition **(Col. 5 Lines 30 – 57);**

means for maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition **(Col. 5 Lines 30 – 57);**

means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product **(Col. 5 Lines 30 – 57; Col. 1 Lines 43 – 47);** and

means for outputting the prognosis to enable the subject to receive the prognosis **(Col. 5 Lines 30 – 57).**

7. In regards to **claim 33**, **Linford** discloses further comprising means for enabling the subject to receive instructions relating to obtaining of the representation **(Col. 5 Lines 54 – 57).**

8. In regards to **claim 34**, **Linford** discloses wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner **(Col. 6 – 8 Lines 66 – 30).**

9. In regards to **claim 35** **Linford** discloses further comprising means for constructing a representative image, wherein said means for generating the prognosis

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compares the constructed image to the information in the database **(Col. 7 – 8 Lines 48 – 42; and wherein it is inherently included that the manipulation of the image is accomplished based on the programming parameters, such as removing wrinkles [see for example Col. 24 – 25 Lines 67 – 2])**.

10. In regards to **claim 36, Linford** discloses wherein the representation comprises at least one image representative image of the external body condition, wherein the information in the database comprises image morphing information, wherein said means for generating the prognosis comprises means for morphing the representative image based on the image morphing information **(Col. 20 – 21 Lines 64 – 3)**.

11. In regards to **claim 38, Linford** discloses wherein the representation is stored in a data storage device, and wherein said means for receiving the representation comprises means for receiving the data storage device **(Col. 1 Lines 30 – 36)**.

12. In regards to **claims 39, 41, and 45, Linford** discloses wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products **(The Examiner asserts that the fact that the subsets of information relate to differing beauty products does not affect how the system works. That is to say, the system is capable of performing various manipulations based on the type of skin imperfection. It is inherent that the system would treat the manipulation process differently depending on the type of skin condition. [See also Col. 25 Lines 19 – 23])**.

13. In regards to **claims 40, 42, and 44, Linford** discloses wherein the means for outputting further comprises means for outputting product information to enable the



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subject to be informed about a beauty product relating to the information in the database used to generate the prognosis (**Col. 1 Lines 30 – 57, wherein the system is capable of displaying information pertaining to a beauty product with the provided monitor**).

14. In regards to **claim 43**, the Examiner asserts that wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, the frequency of use of the product, the length of time between each use of the project, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device does not affect how the system performs the function of manipulating a photo in order to provide a customer with a predicted result of a cosmetic procedure.

15. In regards to **claim 47**, **Linford** discloses a system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one image representative image of the subject's external body condition (**Col. 5 Lines 30 – 57**);

a secondary storage storing a mesh frame representative of at least one part of human anatomy (**Col. 5 Lines 30 – 57**);

a database containing information on how use of at least one beauty product affects evolution of the external body condition (**Col. 5 Lines 30 – 57**);

a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of

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the at least one beauty product (**Col. 5 Lines 30 – 57; Col. 18 Lines 41 – 52; Col. 25 Lines 25 – 27**); and

a driver for outputting the prognosis image to enable the subject to view the prognosis image (**Col. 5 Lines 30 – 57**).

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 1 – 30, 37, 46, and 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Linford et al. (US Patent 6,081,611)** in view of **Proactiv ([http://web.archive.org/web/20010521145551rn\\_1/www.proactiv.com/index.php](http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php))**.

18. In regards to **claims 1 and 48**, **Linford** discloses a method for enabling determination of a prognosis for an external body condition of a subject, the method comprising:

receiving at least one representation of the subject's external body condition (**Col. 1 Lines 35 – 38**);

generating, based on both the received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product (**Col. 1 Lines 43 – 47**); and

outputting the prognosis to enable the subject to receive the prognosis (**Col. 1 Lines 43 – 47**).

**Linford** discloses a method and system where a patient provides a pre-operative digital image, such as images pertaining to wrinkles or skin imperfections (**Col. 25 Lines 19 – 23**), and where the image is then manipulated to provide predicted changes based on a cosmetic surgical procedure as well as the information that is provided during a consultation so that a patient is able to view the after effects of a cosmetic procedure.

**Linford**, however, fails to disclose:

maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition.

However, **Proactiv** discloses how the use of a beauty product affects the evolution of an external body condition, wherein the information is stored in a database.

**Proactiv** discloses how the use of their different products and how the use of various chemicals affect the treatment process

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

As a result, it would have been obvious to look upon the teachings of **Proactiv**, which

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stores additional information regarding a beauty product to show predictable outcomes, and to combine it with the teachings of **Linford** where information is stored within a database to produce a predictable outcome. It would have been well within the ability of one having ordinary skill in the art to use the additional information provided by a beauty product, such as a wrinkle remover, in order to better provide a more accurate predictable outcome of a patient.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Linford** in view of the teachings of **Proactiv** to provide a database containing information of how the use of a beauty product affects the evolution of an external body condition and to better inform a patient of the benefits and limitations of the procedure.

19. In regards to **claims 2 – 3**, **Linford** discloses wherein the at least one representation defines the external body condition (**Col. 1 Lines 35 – 38; wherein it is obvious that the image is defining a condition since it is a pre-operative image**).

20. In regards to **claim 4**, **Linford** discloses, wherein the prognosis comprises a prognosis image (**Col. 1 Lines 42 – 48**).

21. In regards to **claim 5**, **Linford** discloses wherein the prognosis image comprises a three-dimension prognosis image (**Col. 18 Lines 41 – 42; Col. 25 Lines 25 – 27**).

22. In regards to **claim 6**, **Linford** discloses further comprising enabling the subject to receive instructions relating to obtaining of the representation (**Col. 7 – 8 Lines 48 – 42**).

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23. In regards to **claim 7**, **Linford** discloses wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner (**Col. 7 – 8 Lines 48 – 42**).

24. In regards to **claims 8**, **Linford** discloses further comprising constructing an image based on the representation, wherein said generating of the prognosis comprises comparing the constructed image to the information in the database (**Col. 7 – 8 Lines 48 – 42; and wherein it is obviously included that the manipulation of the image is accomplished based on the programming parameters, such as removing wrinkles [see for example Col. 24 – 25 Lines 67 – 2]**).

25. In regards to **claim 9**, **Linford** discloses wherein the wherein the information in the database comprises image morphing information, and wherein said generating of the prognosis comprises morphing the representative image based on the image morphing information (**Col. 20 – 21 Lines 62 – 3**).

26. In regards to **claims 10 and 37**, **Linford** discloses wherein the representation is received via a network, and wherein the subject is located at a location remote from a location where the database is maintained (**Col. 5 Lines 54 – 57 wherein it would have been obvious for one of ordinary skill in the art that an image can be sent through e-mail**).

27. In regards to **claim 11**, **Linford** discloses wherein the representation is stored in a data storage device, and wherein said receiving of the representation comprises receiving the data storage device (**Col. 5 Lines 30 – 36**).

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28. In regards to **claim 12**, **Proactiv** discloses wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products

(<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>).

29. In regards to **claim 13**, **Proactiv** discloses wherein the outputting further comprises outputting product information to enable the subject to be informed about a beauty product relating to the information in the database used to generate the prognosis

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>).

30. In regards to **claim 14**, **Proactiv** discloses wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing manners of using a beauty product

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>).

31. In regards to **claim 15**, **Proactiv** discloses wherein the outputting further comprises outputting usage information to enable the subject to be informed about the manner of beauty product usage relating to the information in the database used to generate the prognosis

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(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

32. In regards to **claim 16**, **Proactiv** discloses wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, frequency of use of the product, the length of time between each use of the product, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

33. In regards to **claims 17 – 19**, although the **combination of Linford and Proactiv** fails discloses wherein the beauty product is chosen from skin products, hair products, and nail products, moisturizers, wrinkle removers, and hair product chosen from a conditioner and a shampoo the Examiner asserts that it would have been obvious to one having ordinary skill in the art that a variety of beauty products can be

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used and all would produce the same predictable result of generating a prognosis showing the effects of using a beauty product.

34. In regards to **claim 20**, **Proactiv** discloses further comprising outputting product purchase information enabling the subject to purchase the beauty product relating to the information in the database used to generate the prognosis

**([http://web.archive.org/web/20010521145551rn\\_1/www.proactiv.com/index.php](http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php)).**

35. In regards to **claim 21**, **Linford** discloses wherein the generating the prognosis comprises comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing (**Linford discloses that a variety of morphing features can be used to create a prognosis depending on the procedure the customer needs/wants, such as wrinkles or other skin imperfections. See also Col. 25 Lines 19 – 23**).

36. In regards to **claims 22 and 46**, **Linford** discloses wherein the outputting the prognosis comprises transmitting the prognosis via a network (**Col. 5 Lines 53 – 57 and wherein it would have been obvious that if a teleconferencing session is used the images can be transmitted via e-mail, for example**).

37. In regards to **claim 23**, **Proactiv** discloses wherein the at least one beauty product is selected from a plurality of differing beauty products, and wherein the method further comprises receiving a selection of the at least one beauty product

**(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,**

**<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,**



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<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

38. In regards to **claim 24**, **Proactiv** discloses further comprising enabling the subject to make the selection of the at least one beauty product from the plurality of beauty products

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

39. In regards to **claim 25**, **Linford** discloses further comprising rendering the prognosis on a three-dimensional mesh image (**Col. 18 Lines 41 – 52; Col. 25 Lines 25 – 27**).

40. In regards to **claim 26**, **Linford** discloses further comprising generating a mathematical model corresponding to a three-dimensional image resulting from the rendering of the prognosis on the three-dimensional mesh image (**Col. 18 Lines 41 – 52; Col. 25 Lines 25 – 27 and wherein it is obviously included that a mathematical model must be used in order to properly carry out the manipulation.**).

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41. In regards to **claim 27**, **Linford** discloses further comprising enabling modification of the representative image based on an input by the subject (**Col. 4 Lines 5 – 14**).

42. In regards to **claim 28**, **Linford** discloses wherein the input by the subject further comprises at least one of the addition and removal of wrinkles from the representative image (**Col. 25 Lines 19 – 23**).

43. In regards to **claim 29**, **Linford** discloses wherein said at least one of the addition and removal of wrinkles comprises modifying at least one parameter associated with a mathematical model corresponding to the image (**obviously included**).

44. In regards to **claim 30**, **Linford** discloses wherein generating at least one prognosis comprises modifying at least one parameter associated with the mathematical model (**obviously included**).

#### **(10) Response to Argument**

##### **Rejection under 35 USC 102**

##### **Claims 31, 32, and 47**

45. In response to appellant's argument that **Linford** fails to disclose a, "database" or any component for storing information on how use of at least one beauty product affects evolution of an external body condition, as well as, a "processor for modifying [a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product", a recitation of the intended use of the claimed

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invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The appellant further argues that, "physician relies on his own knowledge of how a cosmetic surgery would affect a preoperative image, and there is no disclosure of any modification of the image being based on information stored in a database." However, the Examiner asserts that **claims 31, 32, and 47**, discloses a system, which utilizes stored data to allow the user to manipulate an image for enabling a determination of prognosis for an external body condition of a subject. Consequently, it is asserted that in order for the physician to manipulate the provided images, as disclosed by **Linford**, data pertaining to the type of manipulation must be stored within **Linford's** system, since it is necessary information required by the system to allow for the manipulation. In other words, the Examiner asserts that in order for the user to manipulate the image to the desired outcome, the system must require data that instructs the system on how to carry out or perform the manipulation desired by the user.

46. Regarding the applicant's arguments on Page 13 where the appellant argues that the Examiner admits to **Linford** not disclosing a, "database" or any component for storing information on how use of at least one beauty product affects evolution of an external body condition, as well as, a "processor for modifying [a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product" the Examiner asserts that the statement was made towards different

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independent claims, which were directed towards a method and computer instructions.

In other words, the Examiner only made such a statement because the stored data as claimed in **claims 1 and 48** are functional to the usage of the claim, while the data stored in the system of **claims 31, 32, and 47** are nonfunctional descriptive subject matter since the type of data adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art as well as the fact that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

47. Regarding the appellant's argument of **Linford** failing to disclose, "a secondary storage storing a mesh frame representative of at least on part of human anatomy," the Examiner respectfully disagrees. As stated above, the type of data adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art as well as the fact that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Moreover, **Linford** discloses utilizing 3D imaging in order to better represent the prognosis (**see at least Col. 18 Lines 41 - 52**).

**Claims 33 – 36 and 38 – 45**

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48. All rejections made toward dependent **claims 33 – 36 and 38 – 45** are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are patentable over **Linford**.

**Rejection under 35 USC 103**

**Claims 1, 48**

49. Appellant argues that the **combination of Lindford and Proactiv** fails to disclose or suggest that the information in the database is used, in any way, to generate at least one prognosis reflecting predicted changes in an external body condition after use of one or more beauty products. However, as discussed above, **Linford** discloses that two pieces of information are used for providing the predicted prognosis. **Linford** discloses using the patient's pre-operative image as well as the information that was provided during the patient consultation. It would have been obvious to one having ordinary skill in the art that the product discussed during the consultation would have to be taken into account in order to provide an accurate post-operative image. Although, **Linford** does fail that this information is not stored in a database **Linford** does disclose that information stored in a database is used to create the post-operative image. As a result, it would have been well within the ability of one having ordinary skill in the art to look upon **Proactiv** and realized that such information can be stored within the database and that after effects of using a beauty product are provided.

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Therefore, the Examiner asserts that **claims 1 and 48** recites a combination which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under *KSR*. In addition, neither the appellant's specification nor the appellant's arguments present any evidence that modifying **Linford** with the selected elements of **Proactiv** was uniquely challenging or difficult for one of ordinary skill in the art. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify **Linford** to include a database containing information on the effects of using a beauty product of **Proactiv** to allow for generate a prognosis reflecting predicted changes in the external condition after use of the beauty product. Because this is a case where improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

#### **Claims 2 – 30, 37, and 46**

All rejections made toward dependent **claims 2 – 30, 37, and 46** are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are patentable over **Linford** in view of **Proactiv**.

#### **Claims 17 – 19**

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50. In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

**Claim 25**

Appellant argues that the **combination of Linford and Proactiv** fails to disclose, "rendering a prognosis on a three-dimensional mesh image." However, as discussed above, **Linford** discloses using three-dimensional images for creating the prognosis of the individual. The Examiner asserts that the method in which the three-dimensional imaging is being claimed would have been old and well known to one of ordinary skill in the art and that one having ordinary skill would have further realized that there are various methods of creating a three-dimensional image. Moreover, the Examiner also asserts that both **Linford** and the appellant both arrive at the same conclusive result in that both **Linford** and the appellant generate a prognosis of an individual using a three-dimensional representation of the individual and the stored information. The appellant's arguments do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The Examiner asserts that the appellant has not clearly pointed out

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the advantages of using a three-dimensional mesh image over what is already known in the art and how one of ordinary skill in the art would have found it difficult or uniquely challenging in realizing the various advantages and disadvantages that the various methods provides. In other words, depending on the type of rendering required one of ordinary skill in the art would have realized which type of three-dimensional imaging technique would have provided the best results for providing a prognosis of an individual.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.



(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Gerardo Araque Jr.

/Gerardo Araque Jr./

Examiner, Art Unit 3689

October 23, 2008

Conferees:

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/Wynn W. Coggins/

Director, TC 3600

Conferees:

Janice Mooneyham

John Weiss